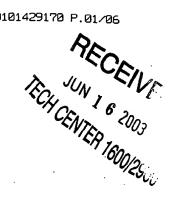
FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP 666 FIFTH AVENUE, 315T FLOOR NEW YORK, NEW YORK 10103-3198 WWW.FULBRIGHT.COM



FACSIMILE TRANSMISSION

_			
n	~	12	٠

May 16, 2003

MATTER NUMBER:

10101429

RECIPIENT(S):	FAX No.:	PHONE No.:	
ATTN: Technology Center Director	703-872-9305		
USPTO, Technology Center 1600			<u>.</u>

FROM:

Norman Hanson

USER ID:

NH01030

FLOOR:

24

PHONE:

(212) 318-3168

FAX:

(212) 318-3400

RE:

LUD 5531.1

Number of Pages with Cover Page:

Message:	 		
		•	. •
•		٠.	
			·

CAUTION - CONFIDENTIAL

THE INFORMATION CONTAINED IN THIS FACSIMILE IS CONFIDENTIAL AND MAY ALSO CONTAIN PRIVILEGED ATTORNEY-CLIENT INFORMATION OR WORK PRODUCT. THE INFORMATION IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHOM IT IS ADDRESSED. IF YOU ARE NOT THIS INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE TO DELIVER IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY USE, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THE PACSIMILE IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE, AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

IF YOU DO NOT RECEIVE A	LL OF THE PAGES, PLEASE CALL
AT	AS SOON AS POSSIBLE

MAY 16 2003 17:13 FR FULBRIGHT JAWORSKI

VIA FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to Commissioner of Patents and Trademarks, Washington, D.C. 2023 I on May

Fulbright & Jaworski L.L.P.

Lauri Olds

LUD 5531.1 DIV(10101429)-NDH

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)

Thierry Boon-Falleur, et al.

Serial No.

09/782,745

Filed

February 13, 2001

For

ISOLATED NUCLEIC ACID MOLECULES WHICH ENCODE

GAGE GENES AND USES THEREOF

Group Art Unit

1644

Examiner

M. DiBrino

May 16, 2003

Hon. Commissioner of Patents Washington, D.C. 20231

Attn: Technology Center Director Technology Center 1600

PETITION FROM FINAL DECISION REQUIRING RESTRICTION IN A PATENT APPLICATION (37 CFR §1.144, MPEP 818.03, MPEP 1002.02(c)).

Pursuant to 37 CFR §1.144, applicants hereby petition from the final decision requiring restriction in this application.

Applicants traversed the requirement and requested reconsideration on May 22, 2002.

No fee is believed due in connection with this petition, but if fees are, in fact due, authorization is given to charge these to Deposit Account 500624.

A Notice of Appeal has not been filed, so this petition is timely filed.

The facts surrounding this case are the following. Applicants presented claims 32-40 in a Second Preliminary Amendment, dated May 2, 2001. Claim 32, as set forth originally recited the following:

"An isolated nucleic acid molecule which encodes a GAGE tumor rejection antigen precursor the amino acid sequence of which is set forth in SEQ ID NO: 27, 28, 29, 30 or 31."

25296712.1

The examiner required restriction to <u>one</u> of SEQ ID NOS: 27, 28, 29 30 and 31. The examiner also asked applicants to correlate nucleotide sequences to the amino acid sequences.

Applicants elected SEQ ID NO: 27, with traverse, and pointed out that SEQ ID NO: 14 encoded SEQ ID NO: 27. See the "Response to Restriction Requirement" dated May 22, 2002.

In an office action, dated August 9, 2002, the examiner made the restriction requirement final, and held claims that did not recite specific nucleotide sequences to be non-enabled.

As a result, applicants cancelled all of the claims then pending, and presented claims 41-49. Claim 41 reads:

"An isolated nucleic acid molecule which encodes a GAGE tumor rejection antigen precursor, the nucleotide sequence of which is set forth at SEQ ID NO: 14, 15, 16, 17, or 18."

The examiner, in a final rejection has objected to claims 41-48, because claim 41 contains SEQ ID NOS: 15-18, which correspond to non-elected subject matter.

Applicants petition from the restriction because it is believed that it is improper.

MPEP 803.04 states, in relevant part:

"Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the office, the Commissioner has decided sua sponte to partially waive the requirements of 37 CFR §1.141 et seq. and permit a reasonable number of such nucleotide sequences to be claimed in a single application ... It has been determined that normally 10 sequences constitute a reasonable number for examination purposes. Accordingly, in most cases up to ten independent and distinct nucleotide sequences will be examined in a single application. . In some exceptional cases, the complex nature of the

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten."

In the present case, only 5 sequences are claimed. Figures 4A-B, GAGE-2, 3, 4, 5 and 6 are presented, and correspond to SEQ ID NOS: 15-18 (GAGE 1 is not claimed in claim 41). There is an extremely high degree of identity amongst SEQ ID NOS: 15-18, as figures 4A-48 show.

25296712.1

LUD 5531.1 DIV(10101429)-NDH

The amino acid sequences of the proteins encoded by these nucleotide sequences do not show exceptional differences. None are claimed, none are recited in the application, and none have been pointed out by the examiner.

It is believed that MPEP 803.04 controls in the present case, especially in the absence of any of the showings which the regulations permit for examination of less than 10 sequences.

In view of this, it is believed that the finality of the restriction requirement is improper, and it is respectfully requested that it be withdrawn.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.

Norman D. Hanson, Esq. Registration No. 30,946